

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO |
|-----------------------------------|-------------|----------------------|---------------------|-----------------|
| 09/833,275 | 04/11/2001 | Andrea Golasinski | 3657/00-786 | 2025 |
| 7590 10/11/2005 | | | EXAMINER | |
| Beirne, Maynard & Parsons, L.L.P. | | | MILEF, ELDA G | |
| 25th Floor | | | | |
| Wells Fargo Tower | | | ART UNIT | PAPER NUMBER |
| 1300 Post Oak Boulevard | | | 3628 | * |
| Houston TX | 77056 | | | |

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | 1/1 | | | |
|--|---|--|---|--|
| | | Application No. | Applicant(s) | |
| | | 09/833,275 | GOLASINSKI ET AL. | |
| Office Action Summary | | Examiner | Art Unit | |
| | | Elda Milef | 3628 | |
| Period fo | The MAILING DATE of this communication apport | <u> </u> | L | |
| WHI(- Exte after - If NO - Failu Any | ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DANSIONS of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing ed patent term adjustment. See 37 CFR 1.704(b). | ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tind will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE | N. nely filed the mailing date of this communication. ED (35 U.S.C. § 133). | |
| Status | | | | |
| 2a) | Responsive to communication(s) filed on This action is FINAL . 2b) This Since this application is in condition for allower closed in accordance with the practice under E | action is non-final. nce except for formal matters, pro | | |
| Disposit | ion of Claims | | | |
| 5)□ 6)⊠ 7)□ | Claim(s) 1-15 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw Claim(s) is/are allowed. Claim(s) 1-15 is/are rejected. Claim(s) is/are objected to. Claim(s) are subject to restriction and/or | vn from consideration. | | |
| Applicat | ion Papers | | | |
| 10) | The specification is objected to by the Examine The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Ex | epted or b) objected to by the drawing(s) be held in abeyance. Se ion is required if the drawing(s) is ob | e 37 CFR 1.85(a). ejected to. See 37 CFR 1.121(d). | |
| Priority : | under 35 U.S.C. § 119 | | | |
| а) | Acknowledgment is made of a claim for foreign All b) Some * c) None of: Certified copies of the priority documents Certified copies of the priority documents Copies of the certified copies of the priority documents application from the International Bureau See the attached detailed Office action for a list | s have been received. s have been received in Applicat rity documents have been receive u (PCT Rule 17.2(a)). | ion No ed in this National Stage | |
| ` | : | or and defining copies have court | | |

Attachment(s)

| 1) X Notice of | References Cited | (PTO-892) |
|----------------|------------------|-----------|
|----------------|------------------|-----------|

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

6) Other: __

4) Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

U.S. Patent and Trademark Office PTOL-326 (Rev. 7-05)

³⁾ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

Art Unit: 3628

DETAILED ACTION

Page 2

Compact Disc Submission

The description portion of this application contains a computer program listing consisting of more than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing of more than three hundred lines <u>must</u> be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(b)(5)). Accordingly, applicant is required to cancel the computer program listing appearing in the specification on pages 10-180, file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c) and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Page 3

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what is meant by line 2 of claim 8, "of data per_____".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 7. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated Antognini PG. Pub. No. US 2005/0033690.

Re claim 13: Antognini disclose:

(a) maintaining electronic information in the computer system for the operation thereof and for receipt and

transmission of data pertaining to a transaction for payment of a bill;

(b) processing said electronic information to identify and sort preselected data;

("In the preferred embodiment, steps 101 through 105 and 115 through 117 are performed by the bill presenter by using a computer system with attached printer and fax/modem where that computer system includes a database of information about bill payers and bill production program and a user interface that allows the bill payer to make the choices and perform the actions outlined below.")—see para. 46-48 and ("the bill payment program derives any digital data from the bill...)—see para. 71-73

(c) introducing into the computer and the electronic information data processed by the machine including: an identification of the billor; the amount of the bill; the amount of payment of the bill through the article of manufacture, defined as currency and/or check -see para. 72 and 73; verifying the identification of the operator if a check is used to pay all or part of the bill -see ("PIN" in para. 63 and "digital signature" in para. 42); receiving through a touch sensitive video screen data pertaining to payment of the bill ("the user will respond by...touching a touchscreen")-see para. 208; scanning a check for financial and source data if said

Art Unit: 3628

check is used for all or part of the payment of the bill through the machine- Fig. 3 and para. 114, 139-141;

Page 5

- (d) electronically formatting said data for transmission to a billor ("The digital representation could be received as an image of machine readable data on paper, an image of machine readable data transmitted by facsimile or other electronic transmission, or direct electronic transmission.")-see para. 77;
- (e) processing the payment of the bill and verifying such payment -see para. 127 and 142;
- (f) electronically transmitting the data pertaining to the payment of the bill to a location designated by the billor for storage within and read out on a computer system of the billor. ("In the preferred embodiment, steps 101 through 105 and 115 through 117 are performed by the bill presenter by using a computer system with attached printer and fax/modem where that computer system includes a database of information about bill payers and bill production program and a user interface that allows the bill payer to make the choices and perform the actions outlined below.")-see para. 46-48,63,77.

Art Unit: 3628

Claim Rejections - 35 USC § 103

Page 6

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere*Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 2. Claims 1-3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini (Antognini et al. US PG. Pub. No. US 2005/0033690 in view of Fleet ("Fleet Adds Foreign Language Options to More ATMs" [online]. ATM marketplace.com, March 30, 2001 [retrieved on September 12, 2005]. Retrieved from

Art Unit: 3628

the Internet:

<http://www.atmmarketplace.com/news story 5618.htm>

Re claim 1: Antognini disclose:

(1) a support structure ("the computerized equipment
of a third party...automated teller machines ("ATM"s)")-see para
63.;

Page 7

- (2) electronic means within said support structure for transmitting data to and pertaining to the payment of said bill to the payor ("preferably after asking the bill payer to confirm payment of the bill, the ATM then processes the transaction, pays the bill presenter through electronic funds transfers or other methods of payment acceptable to the maintainer") -see para. 63 and ("Upon completion of the bill payments, the ATM preferably issues a receipt to the bill payer.")-see para 65;
- (3) means secured to said support structure for electronically scanning said bill to identify and retrieve predeterminable data on the bill ("("ATM"S)...or kiosks ...equipment could scan and decode the digital data on printed on bills")-see para 63.;
- (4) a microprocessor ("the computerized equipment")-see
 63.;

Art Unit: 3628

(5) means carried by said structure for optically scanning and accepting a check presented on behalf of the payor for payment of the bill ("In step 107, the bill payer selects the method to pay the bill...choices: credit card, debit card, check")-see para. 72 and ("The bill payment program then uses that digital data to inform the bill payer which methods of bill payment are acceptable to the bill presenter, and to prepare the digital data contained in the bill payment instrument. preferred embodiment, the bill payment program creates digital data for the bill payment instrument by concatenating the bill's digital data with the digital data that constitutes the bill payment instrument.") - see para 71 and ("In one embodiment, notwithstanding the advantages of machine readable code, the bill presenter can choose to image a purely human readable instrument and rely on the OCR and/or ICR technologies for conversion.")-see para. 114;

Page 8

- (6) video monitor means including a screen responsive to touch initiated by a human operator ("The user will respond by... touching a touchscreen.")-see para. 208.
- (7) means for generating on said screen a video instruction image for operation of the machine by the operator ("At this point, the set of transactions will be described to the user via

Art Unit: 3628

a text or graphical display, or via a voice description (box 603)")-see para. 208 and ("current ATM protocols")-para. 63;

Page 9

(8) Antognini disclose means for generating an audio signal concurrently with the video instruction image ("At this point, the set of transactions will be described to the user via a text or graphical display, or via a voice description (box 603).") - see para 208. and ("current ATM protocols") -para. 63;

Antognini do not disclose in a pre-selected language.

Fleet however, shows ("FleetBoston Financial is upgrading its

ATMs to provide screen instructions in English, Spanish,

Chinese...")-see para. 1, page 1 and ("Last month, Fleet announced

plans to introduce 1,420 "talking ATMs" for visually

impaired...Fleet is investigating the feasibility of meeting the

foreign language needs of the visually impaired for future

use.")-see para. 3, p. 2. It would have been obvious to one

having ordinary skill at the time the invention was made to have

modified Antognini to include means for generating an audio

signal with video instruction in a pre-selected language as was

done by Fleet in order meet the needs of diverse communities and

the visually impaired.

Antognini disclose:

Page 10

Art Unit: 3628

(9) a computer program means with said microprocessor in said structure for operating said computer to store data pertaining to said payment; for generating commands for processing the payment for computing data received through the optical scanning means, for controlling the video monitor, the video instruction, the means for generating the audio signal, and for applying the payment of said bill and electronically transmitting data pertaining to said payment to the billor.

("steps 101 through 105 and 115 through 117 are performed by the bill presenter using a computer system...")—see para. 46,63,73,

Re claim 2: Antognini disclose:

wherein the means for electronically scanning said bill further comprises means for identification of the billor, identification of the bill, the amount owed for the bill, and data pertaining to the billor. ("ATMs..or kiosks could be equipped with scanners...scan and decode the digital data printed on bills...")—see para. 63 and ("The instruments contain digital data that preferably includes, the bill presenter's name, address, and account number, amount being paid,...and any other information included in digital form... on the bill...")—see para.

Application/Control Number: 09/833,275 Page 11

Art Unit: 3628

Re claim 3: Antognini disclose:

wherein data is transmitted in real time. -see para.

54

Re claim 8: Antognini disclose:

a computer program means for storage of data per at least one bill payment and for transmission of data pertaining to each said payment subsequent loss and re-establishment of an electronic communications line between the machine and a central location. ("In manual preparation, the bill payer uses the traditional manual check writing and recording, generally followed by inserting the bill and check into an envelope, sealing the envelope, applying postage, and mailing the envelope. The invention nonetheless offers the advantage of allowing the bill payer to archive the bill which contains digital data. The bill payer can later access that digital data--e.g. to import the digital data into a personal finance software application or to just store the data on the bill payer's computer for reference. If the bill was received on paper and the bill payer chooses manual preparation, the bill payer would have to scan and decode the digital data in order to input into the bill payer's computer.")-see para. 61.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini in view of Fleet as applied to claim 1 above, in further view of Patterson (Patterson, Kelly D.; Window Shopping: Rangers Fans Show Up in Force for Single Game Tickets club Plans New Ways to Make Buying Tickets Easier.

Dallas Morning News. Feb. 8, 1998).

Re claim 4: Antognini and Fleet do not specifically disclose wherein a plurality of video monitor screens are provided and carried by the support structure, and said computer program enables display on at least one of said video monitor means if another of said video monitor screens is inoperable. however, shows ("The machine looks like a traditional ATM but it has two screens...") - see p. 2, para.7. It would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify Antognini and Fleet to include having two screens as was shown by Patterson to accommodate advertising. Patterson does not expressly disclose that the operation of one is dependant on the other, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the advertising screen to display the financial transaction if the other screen becomes inoperable to facilitate the operation of the claimed machine.

4. Claims 5,6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini in view of Fleet in further view of Trusty(Trusty Old Cash Remains A Major Factor in Banking. American Banker. New York, N.Y.: Mar. 21 2000. Vol.165, Iss. 55; pg. 6)

Re claim 5: Antognini and Fleet disclose steps 1, 2,3,6,7,8, and 9 as in claim 1 above and:

Antognini further discloses:

(4) a computer program means within a computer in said structure for operating said computer to store retrieved data pertaining to said payment and for generating commands to the machine for processing the payment -see para. 63 and ("The process starts with decisions to be made by the bill presenter. The bill presenter prepares and sends a bill to the bill payer. This process starts with step 101, in which the bill production program accesses the information from the database traditionally accessed for each bill...")-see para. 47;

Although Antognini disclose that the bill payer has a choice of payment options including cash -see para. 72, Antognini do not specifically disclose:

(5) means carried by said structure for optically scanning legal currency presented on behalf of the payor for payment of the bill. Trusty, however shows ("When I deposit cash, an optical scanner will read the serial numbers, give the bank back its reserves, and add the amount to my account. Then the bills will be chopped up.")—see page 2, para. 10.

Therefore, it would have been obvious at the time the invention was made to modify Antognini to include scanning currency presented on behalf of the payor as was done by Trusty in order to offer different payment options.

Re claim 6: Antognini and Fleet do not disclose:

means for counting said currency and identifying the total of individual denominations of said currency optically scanned and accepted by said optically scanning means. Trusty, however shows ("When I deposit cash, an optical scanner will read the serial numbers, give the bank back its reserves, and add the amount to my account. Then the bills will be chopped up.")-see page 2, para. 10. Therefore, it would have been obvious at the time the invention was made to modify Antognini and Fleet to include scanning currency presented on behalf of the payor as was done by Trusty in order to offer different payment options.

Page 15

Art Unit: 3628

Re claim 8: Antognini disclose:

a computer program means for storage of data per at least one bill payment and for transmission of data pertaining to each said payment subsequent loss and re-establishment of an electronic communications line between the machine and a central location. ("In manual preparation, the bill payer uses the traditional manual check writing and recording, generally followed by inserting the bill and check into an envelope, sealing the envelope, applying postage, and mailing the envelope. The invention nonetheless offers the advantage of allowing the bill payer to archive the bill which contains digital data. The bill payer can later access that digital data--e.g. to import the digital data into a personal finance software application or to just store the data on the bill payer's computer for reference. If the bill was received on paper and the bill payer chooses manual preparation, the bill payer would have to scan and decode the digital data in order to input into the bill payer's computer.") - see para. 61.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over over Antognini in view of Fleet as applied to

claim 1 above, in further view of Korman et al. (US Patent No. 6,308,887).

Re claim 7: Antognini and Fleet do not disclose a means at a remote location relative to said machine for electronically overriding and controlling the operation of the machine at least during payment of said bill. Korman et al. disclose ("the transaction network of claim 4 wherein the processor comprises a host computer remote from said transaction terminal") - see col. 12, lines 57-59 and ("The PC in the Super-ATM and the remote host computer 40 may use a distributed client/server architecture, to enable "on the fly" changes through changes made to the host computer software...") - see col. 8, lines 51-54 and ("For example, if a user initiated a bill payment transaction...") -see col. 3, lines 66-67 and cols. 8-10. would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Antognini and Fleet to include controlling the operation of the machine at a remote location relative to the machine (host computer) as was done by Korman in order to enable changes to the functioning of the ATM.

6. Claims 9-12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini in view of Korman et al. in further view of Ray et al. (US Patent No. 6,321,981).

Re claim 9: Antognini disclose:

- (a) advising the operator of the machine incorporating said computer, through at least one of video and audio display, that it is not necessary to fill out the amount of said check or apply a signature to said check;
- (b) prompting the operator to introduce the check into the bill payment machine;

("In step 109, the bill payer next selects a method of signing the bill payment instrument. The choices preferably include at a minimum: no signature, manual signature, stamped signature, computer printed signatures, digitized manual signature and digital signature.")—see para. 82 and ("A digital signature preferably contains the amount and date of payment, the payee, the bill payer's account number with the bill presenter, the checking or other financial account number, the financial organization the funds are drawn on, the reason for the payment and other information pertinent to the payment. The digital signature can also contain a digitized manual signature.

The digitized signature is digital data which is added to the bill payment instrument in a manner consistent with the manner of adding other digital data discussed above.")-see para. 83

- (c) optically scanning said check for retrieval of data contained on the check; ("In step 107, the bill payer selects the method to pay the bill...choices: credit card, debit card, check"/)—see para. 72 and ("The bill payment instruments imaged are preferably those that contain digital data in machine readable form. The instruments can also contain human readable information but the information used for further processing is preferably in digital form so as to introduce the advantages of machine readable code over optical character recognition (OCR).")—see para. 114.
- (d) transmitting and storing the data retrieved from the check into the computer-see para. 63 and ("The second possibility is consistent with the current practice of using accounting software for the entry and reconciliation of bill payments. This possibility encompasses sophisticated COBOL or other language systems employed by large organizations as well as personal finance software applications employed on personal computers. If checks are written by the system, recording is usually automatic.")—see para. 92 and para. 80

Art Unit: 3628

(e) recording an image of the check and transmitting the image into the database of the computer for storage of the check ("The fifth possibility involves receiving digital representations of the bill payment instruments together with the bill payment instruments and/or images of the bill payment instruments and/or images of the bill payment instruments and/or a listing of the payments made...The purpose of human readable information is self-evident--to allow the bill payer to view the information. The purpose of the machine readable information is to allow the bill payer to both archive the information and use the information for further analysis, such as importing into personal finance software program.")-see para. 80;

Page 19

- (f) prompting the operator to manually enter into the machine the monetary amount of the check ("In those instances where the bill payer uses a computer system (either of the bill payer or a third party)...In the preferred embodiment, the bill payment program can pay an amount different from that provided in the bill by allowing the bill payer the choice to override the bill payment amount.")—see para. 71;
- (g) returning the check to the operator ("the bill payer selects the method for receiving back the bill payment instruments. The choices preferably include at a minimum, receiving the physical bill payment instrument...")-see para. 74;

Art Unit: 3628

Antognini disclose:

(h) digitally recording an image of the operator ("An endorsement that includes an <u>image of the payee</u> provides proof of who received payment. This possibility might be particularly useful in the context of governmental checks sent to individuals, such as social security, welfare, and tax refund checks. Including such images could significantly reduce the incidence of fraud and, where fraud does occur, assist in the apprehension of the perpetrators. The image captured at the time of cashing or depositing could be printed on the bill payment instrument in human readable form and/or preferably included in <u>digital form</u>.")-see para. 107.

Page 20

Antognini does not expressly disclose transmitting said image to said computer for storage. Korman however, teaches ("In the preferred embodiment, the Super-ATM biometric system 210 is a facial measurement security system whereby the thermal aspects of a user's face is measured and compared to a prestored thermal signature of the user's face.")—see col. 6, lines 31-35, and Fig. 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Antognini to include storing the image of a user's face as was

Art Unit: 3628

done by Korman in order to provide a method of endorsing the bill payment instruments and to reduce the incidence of fraud.

Page 21

Although Antognini and Korman disclose inserting an ATM card and entering a PIN for identification purposes, they do not specifically disclose (i) verifying the identification of the operator by optically scanning an identification document and storing predeterminable information thereon in said computer. Ray, however, teaches ("The digitized image data retrieved with the optical scanner is also delivered to the processor and the embedded data is retrieved therefrom to generate a second data set.")—see col. 5, lines 33-36, and Fig.1. Therefore, it would have been obvious to one having ordinary skill in the art at the time that the invention was made to have modified Antognini and Korman to include optically scanning an identification card and comparing the information on the card to the information stored in a database as was taught by Ray in order to prevent the fraudulent use of financial systems.

Antognini disclose:

(j) prompting the operator to confirm through the machine that the operator is an authorized signor of said account identified on said check ("After inserting a banking card and entering a PIN, consistent with current ATM protocols, a bill payer is presented with a number of choices, one of which is

payment of bills.")-see para. 63 and ("digital signature")-see para. 83

(k) electronically transmitting data from the check to said financial institution for a deduction of the monetary amount of the check entered into the machine by the operator from said account. ("Preferably after asking the bill payer to confirm payment of the bill, the ATM then processes the transaction, pays the bill presenter through electronic funds transfers or other methods of payment acceptable to the maintainer (e.g., the owner of the ATM, such as a bank.")—see para. 63.

Re claim 10: Antognini, Korman and Ray disclose steps a-j as in claim 9 above.

Antognini disclose:

(k) converting data transmitted and stored from the check into the computer to an ACH transaction and electronically transmitting said transaction to said financial institution for a deduction from said account of the monetary amount of the ACH transaction as defined by the amount entered into the machine for the check by the operator. ("In step 121, the bank, credit card company or other intermediary selects a method for settling payments between the bill presenter and the bill payer.

Art Unit: 3628

The bank, credit card company or other intermediary receiving the payment instrument may choose to settle directly with the bill presenter and bill payer, or with the bank, credit card company or other intermediary representing the other party, or with a clearing house that acts as a further intermediary.

A bank might choose to use the Federal Reserve, the Automated Clearing House, or a debit card network.")—see para. 127 and para. 63.

Re claim 11: Antognini, Korman and Ray disclose steps a-k as in claim 10 above.

Re claim 12: Antognini, Korman, and Ray disclose steps a-k as in claim 9 above.

Re claim 14: Antognini disclose the computer program causes a computer to perform the further step of: converting a check into an ACH transaction and electronically transmitting data pertaining to said transaction to at least a financial institution. ("In step 121, the bank, credit card company or other intermediary selects a method for settling payments between the bill presenter and the bill payer. The bank, credit card company or other intermediary receiving the payment instrument may choose to settle directly with the bill presenter

and bill payer, or with the bank, credit card company or other intermediary representing the other party, or with a clearing house that acts as a further intermediary. A bank might choose to use the Federal Reserve, the <u>Automated Clearing House</u>, or a debit card network.")—see para. 127 and para. 63.

Page 24

Re claim 15: Antognini do disclose paying a bill using cash as an option.-see para. 72. Antognini do not disclose counting the respective denominations of currency through the article of manufacture used for payment of the bill and sorting each of denominations and computing the amount of currency in each of said denominations. Korman, however shows ("allowing the user to perform a variety of transactions, from paying bills to making purchases, utilizing a variety of payment means, including coins, currency, credit cards, debit cards, smart cards, and the like.")-see col. 2, lines 52-55 and ("On a scheduled interval, the Super-ATMs may transmit data regarding amount of coins stored, amount of currency received...")-see col. 9, lines 52-55. Korman does not expressly disclose sorting each of the denominations, but it is well known in the art that sorting by denominations needs to take place in order to arrive at an amount of currency received. Therefore, it would have been obvious to one having ordinary skill in the art at the time the

Art Unit: 3628

invention was made to modify Antognini to include accepting currency deposits to apply to bill payments, and sorting the currency in order to arrive at the amount of currency received as was done by Korman in order to provide the payer with another bill payment option.

Page 25

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,554,184 (Amos) - Cited for an automatic instant money transfer machine.

US PG. Pub. No. US 2002/0129256 (Parmelee et al.) - Cited for an automated transaction machine digital signature system and method.

US PG. Pub. No. US 2005/0091161 (Gustin) - Cited for an automated banking system for dispensing money orders, wire transfer, and bill payment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

Application/Control Number: 09/833,275 Page 26

Art Unit: 3628

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

* * *

SUPETIVISORY POTENT EXAMINER TECHNOLOGY CONTER 3600